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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,884	11/13/2001	Hiroyuki Onishi	U 013711-6	5111
140	7590	03/14/2005	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			FLETCHER III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 03/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/009,884	<b>Applicant(s)</b> ONISHI ET AL.	
	<b>Examiner</b> William P. Fletcher III	<b>Art Unit</b> 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 11-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-10,67 and 68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/26/04&amp;12/27/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>definition of "derivative"</u> .       |

## **DETAILED ACTION**

### ***Response to Amendment***

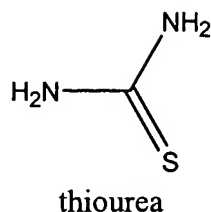
1. Receipt is acknowledged of applicant's amendment and response filed 12/13/2004. To clarify the record at this point in the prosecution, claims 1 and 4-68 are pending, of which claims 4-7 and 11-66 are withdrawn from consideration.

### ***Information Disclosure Statement***

2. The information disclosure statements (IDS) submitted on 11/26/2004 and 12/27/2004 were filed after the mailing date of the non-final Office action on 9/9/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Response to Arguments***

3. Applicant's arguments in the above-mentioned response, with respect to the rejections set-forth in the Office action mailed 9/9/2004, have been fully considered and are persuasive. Independent claim 1 has been amended to recite that the treatment agent comprises at least one sulfur compound. Since none of the JP references cited in paragraphs 7-9 of the above-mentioned action teach a sulfur compound, the rejections in view of these references are withdrawn. Further, applicant's arguments with respect to the Shores reference are persuasive. It is the examiner's position that the "reaction product" disclosed by Shores at 3:26-29 is the overall poly-condensation reaction product A+B+C. It is the examiner's position that, although referred to as "thiourea," because it is a poly-condensation reaction product, it cannot read on canonical thiourea, *per se*:



and, because this poly-condensation reaction product is not disclosed by Shores as being obtained from thiourea by chemical reaction, it cannot be considered a 'derivative' thereof<sup>1</sup>. Consequently, the rejection in view of this reference is withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mones et al. (US 3,028,252 A) below.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. **Claims 1, 8-10, 67, and 68 are rejected under 35 U.S.C. 102(b) as being anticipated by Mones et al. (US 3,028,252 A).**

With respect to claims 1, 8, 10, and 67, this reference teaches a process in which a paper, having an image marked thereon, is coated with a protective coating. The protective coating composition comprises thiourea or a derivative thereof, as well as a natural (rosin) or synthetic (glycerol phthalate, polyvinyl acetate) resin. See 1:10-65; 2:5-10 and 29-35; 3:30-40; Examples; 4:10-75; and claims.

With respect to claims 67 and 68, this reference explicitly teaches that the coating protects the markings from light degradation (i.e., provides light resistance). Although this reference does not explicitly state that the coating provides the claimed gas resistance, it is the

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<sup>1</sup> See attached definition of "derivative" from *Hackh's Chemical Dictionary*.

examiner's position that such is an inherent physical property of the coating. Since this reference disclosed the same treatment agent coated on the same substrate in the same fashion as claimed by applicant, it is the examiner's position that, absent evidence to the contrary, the protective coating of Mones inherently provides the claimed gas resistance.

With respect to claim 9, it is the examiner's position that, although the paper of Mones is marked electrolytically, as described at 1:10-25, this same fax paper is inherently capable of being marked by an ink (from a pen, for example). Insofar as this is the case, it is the examiner's position that the paper may be considered as having an ink-receptive layer on a support.


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
TIMOTHY MEEKS  
PRIMARY EXAMINER

  
William P. Fletcher III

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